

## PATENT COOPERATION TREATY

## PCT

INTERNATIONAL PRELIMINARY REPORT ON PATENTABILITY  
(Chapter I of the Patent Cooperation Treaty)

(PCT Rule 44bis)

|  |   |   |                  |
|--|---|---|------------------|
| Applicant's or agent's file reference<br>PIP155CARRP-PCT   | <b>FOR FURTHER ACTION</b>   |   | See item 4 below |
| International application No.<br>PCT/US2004/026736   | International filing date ( <i>day/month/year</i> )<br>13 September 2004 (13.09.2004) | Priority date ( <i>day/month/year</i> )<br>22 September 2003 (22.09.2003) |                  |
| International Patent Classification (8th edition unless older edition indicated)<br>See relevant information in Form PCT/ISA/237 |   |   |                  |
| Applicant<br>CATALINA MARKETING INTERNATIONAL, INC.  |   |   |                  |

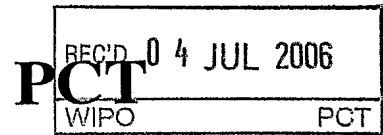
- This international preliminary report on patentability (Chapter I) is issued by the International Bureau on behalf of the International Searching Authority under Rule 44 *bis*.1(a).
- This REPORT consists of a total of 4 sheets, including this cover sheet.  
  
In the attached sheets, any reference to the written opinion of the International Searching Authority should be read as a reference to the international preliminary report on patentability (Chapter I) instead.
- This report contains indications relating to the following items:
 

|                                     |              |   |
|-------------------------------------|--------------|---|
| <input checked="" type="checkbox"/> | Box No. I    | Basis of the report   |
| <input type="checkbox"/>            | Box No. II   | Priority  |
| <input type="checkbox"/>            | Box No. III  | Non-establishment of opinion with regard to novelty, inventive step and industrial applicability  |
| <input type="checkbox"/>            | Box No. IV   | Lack of unity of invention  |
| <input checked="" type="checkbox"/> | Box No. V    | Reasoned statement under Article 35(2) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement |
| <input type="checkbox"/>            | Box No. VI   | Certain documents cited   |
| <input type="checkbox"/>            | Box No. VII  | Certain defects in the international application  |
| <input type="checkbox"/>            | Box No. VIII | Certain observations on the international application   |
- The International Bureau will communicate this report to designated Offices in accordance with Rules 44bis.3(c) and 93bis.1 but not, except where the applicant makes an express request under Article 23(2), before the expiration of 30 months from the priority date (Rule 44bis .2).

|   |   |
|---|---|
| The International Bureau of WIPO<br>34, chemin des Colombettes<br>1211 Geneva 20, Switzerland<br><br>Facsimile No. +41 22 338 82 70 | Date of issuance of this report<br>22 August 2006 (22.08.2006)      |
|   | Authorized officer<br><br>Nora Lindner<br><br>e-mail: pt02@wipo.int |

# PATENT COOPERATION TREATY

From the  
INTERNATIONAL SEARCHING AUTHORITY



## WRITTEN OPINION OF THE INTERNATIONAL SEARCHING AUTHORITY

(PCT Rule 43bis.1)

To:  
RICHARD A. NEIFELD  
NEIFELD IP LAW, P.C.  
2001 JEFFERSON DAVIS HIGHWAY, SUITE 1001  
ARLINGTON, VA 22202

Date of mailing  
(day/month/year) **28 JUN 2006**

Applicant's or agent's file reference

**FOR FURTHER ACTION**

See paragraph 2 below

PIP155CARRP-PCT

International application No.

International filing date (day/month/year)

Priority date (day/month/year)

PCT/US04/26736

13 September 2004 (13.09.2004)

22 September 2003 (22.09.2003)

International Patent Classification (IPC) or both national classification and IPC

IPC(7): G06F17/60 and US Cl.: 705/14

Applicant

CATALINA MARKETING INTERNATIONAL, INC

1. This opinion contains indications relating to the following items:

- ☒ Box No. I Basis of the opinion
- ☐ Box No. II Priority
- ☐ Box No. III Non-establishment of opinion with regard to novelty, inventive step and industrial applicability
- ☐ Box No. IV Lack of unity of invention
- ☒ Box No. V Reasoned statement under Rule 43bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement
- ☐ Box No. VI Certain documents cited
- ☐ Box No. VII Certain defects in the international application
- ☐ Box No. VIII Certain observations on the international application

### 2. FURTHER ACTION

If a demand for international preliminary examination is made, this opinion will be considered to be a written opinion of the International Preliminary Examining Authority ("IPEA") except that this does not apply where the applicant chooses an Authority other than this one to be the IPEA and the chosen IPEA has notified the International Bureau under Rule 66.1bis(b) that written opinions of this International Searching Authority will not be so considered.

If this opinion is, as provided above, considered to be a written opinion of the IPEA, the applicant is invited to submit to the IPEA a written reply together, where appropriate, with amendments, before the expiration of 3 months from the date of mailing of Form PCT/ISA/220 or before the expiration of 22 months from the priority date, whichever expires later.

For further options, see Form PCT/ISA/220.

3. For further details, see notes to Form PCT/ISA/220.

Name and mailing address of the ISA/ US

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Commissioner for Patents  
P.O. Box 1450  
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Authorized officer

Eric Stamber

Telephone No. 571-272-3600

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.

PCT/US04/26736

**Box No. I Basis of this opinion**

1. With regard to the **language**, this opinion has been established on the basis of the international application in the language in which it was filed, unless otherwise indicated under this item.

☐ This opinion has been established on the basis of a translation from the original language into the following language \_\_\_\_\_, which is the language of a translation furnished for the purposes of international search (under Rules 12.3 and 23.1(b)).

2. With regard to any **nucleotide and/or amino acid sequence** disclosed in the international application and necessary to the claimed invention, this opinion has been established on the basis of:

a. type of material

☐ a sequence listing

☐ table(s) related to the sequence listing

b. format of material

☐ in written format

☐ in computer readable form

c. time of filing/furnishing

☐ contained in international application as filed.

☐ filed together with the international application in computer readable form.

☐ furnished subsequently to this Authority for the purposes of search.

3. ☐ In addition, in the case that more than one version or copy of a sequence listing and/or table relating thereto has been filed or furnished, the required statements that the information in the subsequent or additional copies is identical to that in the application as filed or does not go beyond the application as filed, as appropriate, were furnished.

4. Additional comments:

**WRITTEN OPINION OF THE  
INTERNATIONAL SEARCHING AUTHORITY**

International application No.  
PCT/US04/26736

**Box No. V Reasoned statement under Rule 43 bis.1(a)(i) with regard to novelty, inventive step or industrial applicability; citations and explanations supporting such statement**

**1. Statement**

|                               |   |     |
|-------------------------------|---|-----|
| Novelty (N)                   | Claims <u>4-10, 12-35, 39-45, 47-70</u> | YES |
|                               | Claims <u>1-3, 11, 36-38, 46</u>        | NO  |
| Inventive step (IS)           | Claims <u>4-10, 12-35, 39-45, 47-70</u> | YES |
|                               | Claims <u>1-3, 11, 36-38, 46</u>        | NO  |
| Industrial applicability (IA) | Claims <u>1-70</u>                      | YES |
|                               | Claims <u>NONE</u>                      | NO  |

**2. Citations and explanations:**

**1. Claims 1-3, 11, 36-38, and 46 do not meet the criteria set out in PCT Article 33(2)-(4) as being anticipated by Katz et al. , US 6.055,513 (SEE AT LEAST abstract, Figs. 1-7 and associated text).**

Katz discloses apparatus and methods for effecting remote commerce, such as in telemarketing (either inbound or outbound) and in electronic commerce, which are particularly adapted for the intelligent selection and proffer of products, services or information to a user or customer. Goods, service or information are provided to the user via electronic communication, such as through a telephone, videophone or other computer link, as determined by the steps of first, establishing communication via the electronic communications device between the user and the system to effect a primary transaction or primary interaction, second, obtaining data with respect to the primary transaction or primary interaction, including at least in part a determination of the identity of the user or prospective customer (i.e. a database containing CID and apparatus for access thereto as claimed is disclosed) , third, obtaining at least a second data element relating to the user (i.e. "non-transaction demographic data" as claimed), fourth, utilizing the primary transaction or primary interaction data along with the at least second data element as factors in determining at least one good, service or item of information for prospective upsell to the user or prospective customer, and offering the item to the prospective customer. In the preferred embodiment, the selection of the proffer of goods, services or information comprises an upsell with respect to the primary transaction (i.e. transaction data as claimed is disclosed) or primary interaction data. The offer of the upsell is preferably generated and offered in real time, that is, during the course of the communication initiated with the primary transaction or primary interaction. As such Katz anticipates claims 1-3, 11, 36-38, and 46 .

**2. Claims 4-10, 12-35, 39-45, 47-70 meet the criteria set out in PCT Article 33(2)-(3) since the prior art does not teach or fairly suggest the claimed feature of a value for the assumed non-transaction demographic data field is a probability or an expectation.**

**3. Claims 1-70 meet the criteria set out in PCT Article 33(4) and thus have industrial applicability since the subject matter claimed can be made or used in industry.**

O-003

## INTERNATIONAL SEARCH REPORT

International application No.

PCT/US04/26736

## A. CLASSIFICATION OF SUBJECT MATTER

IPC: G06F 17/60 B

USPC: 705/14

According to International Patent Classification (IPC) or to both national classification and IPC

## B. FIELDS SEARCHED

Minimum documentation searched (classification system followed by classification symbols)

U.S. : 705/14

Documentation searched other than minimum documentation to the extent that such documents are included in the fields searched

Electronic data base consulted during the international search (name of data base and, where practicable, search terms used)  
East

## C. DOCUMENTS CONSIDERED TO BE RELEVANT

| Category * | Citation of document, with indication, where appropriate, of the relevant passages                     | Relevant to claim No. |
|------------|--|-----------------------|
| X          | US 6,055,513 A (KATZ et al) 25 April 2000 (25.04.2000), see Abstract, Figures 1-7 and associated text. | 1-3, 11, 36-38, 46    |
| A          | US 6,073,112 A (GEERLINGS) 06 June 2000 (06.06.2000)   | 1-3, 11, 36-38, 46    |



Further documents are listed in the continuation of Box C.



See patent family annex.

| Special categories of cited documents:   |  |
|--|--|
| * "A" document defining the general state of the art which is not considered to be of particular relevance   | "T" later document published after the international filing date or priority date and not in conflict with the application but cited to understand the principle or theory underlying the invention  |
| "E" earlier application or patent published on or after the international filing date  | "X" document of particular relevance; the claimed invention cannot be considered novel or cannot be considered to involve an inventive step when the document is taken alone   |
| "L" document which may throw doubts on priority claim(s) or which is cited to establish the publication date of another claim or other special reason (as specified) | "Y" document of particular relevance; the claimed invention cannot be considered to involve an inventive step when the document is combined with one or more other such documents, such combination being obvious to a person skilled in the art |
| "O" document referring to an oral disclosure, use, exhibition or other means   | "Z" document member of the same patent family  |
| "P" document published prior to the international filing date but later than the priority date claimed   |  |

Date of the actual completion of the international search

12 May 2006 (12.05.2006)

Date of mailing of the international search report

28 JUN 2006

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